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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL-DAVID MORRISON and GERARDO GARCIA

Appeal 2009-000401
Application 09/738,050
Technology Center 2100

Decided: June 29, 2010

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-3, 5-23, 27-31, and 37-45. Claim 4 is canceled. Claims 24-26 and 32-36 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The invention relates to a method and apparatus for an interactive catalog (Spec. 1, ll. 6-7).

Independent claim 1 is illustrative:

1. A method for presenting a portion of an electronic catalog database, the method comprising steps of:

presenting a first tier of tabs, each tab in the first tier of tabs representing a first collection of data objects corresponding thereto;

in response to a selecting of a tab of the first tier to produce a selected first tier tab, presenting a second tier of tabs, each tab in the second tier of tabs representing a second collection of data objects, each data object in the second tier also belonging to the first collection of data objects corresponding to the selected first tier tab;

in response to a selecting of a tab of the second tier to produce a selected second tier tab, presenting a third tier of tabs, each tab in the third tier of tabs representing a third collection of data objects, each data object in the third tier also belonging to the second collection of data objects corresponding to the selected second tier tab, and continuing to present at least a portion of the first tier after the tab of the second tier is selected; and

in response to a selecting of a tab of the third tier, displaying a page from the electronic catalog database, and continuing to present at least a portion of the first tier and at least a portion of the second tier after the tab of the third tier is selected.

References

The Examiner relies upon the following references as evidence in support of the rejection:

Bodnar	US 2001/0000668 A1	May 3, 2001 (continuation of application 08/905,463, filed on Aug. 4, 1997)
Wical	US 6,240,410 B1	May 29, 2001 (filed May 28, 1999)
Wittenburg	US 6,515,656 B1	Feb. 4, 2003 (filed Apr. 30, 1999)
Suzuki	US 6,798,427 B1	Sep. 28, 2004 (filed Jan. 21, 2000)

Rejections

Claims 1-3, 5-16, 18-23, 37-40, and 42-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wical and Suzuki.

Claims 17 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wical, Suzuki, and Wittenburg.

Claims 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wical, Suzuki, and Bodnar.

ISSUES

Issue 1

The Examiner finds that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Suzuki in the invention of Wical in order to provide a visual presentation of all the hierarchical menu options at all levels of the hierarchical structure and to provide a visual presentation of the hierarchical relationship of all menu options at one level to another level” (Ans. 4).

Appellants argue that the combination of Wical and Suzuki “is one of apples and oranges from both the subject matter (literature search versus music editing) and from architecture (drill down and display one item of information at a time versus displaying and editing four distinct output screen segments simultaneously)” (App. Br. 14).

Issue: Did the Examiner err in finding that it would have been obvious to an artisan to combine the teachings and suggestions of Wical and Suzuki?

Issue 2

The Examiner finds that Wical teaches “in response to a selecting of a menu option of [a] third tier, displaying a page from [an] electronic catalog database” (Ans. 3-4).

Appellants argue that “Wical does not describe representing knowledge from catalogs” (App. Br. 21).

Issue: Did the Examiner err in finding that Wical and Suzuki would have taught or suggested in response to a selecting of a tab of a third tier, displaying a page from an electronic catalog database?

Issue 3

The Examiner finds that Wical teaches an “electronic catalog database [that] comprises a plurality of products” (Ans. 5).

Appellants submit that “Wical does not teach selling these books, or any other product” (App. Br. 22).

Issue: Did the Examiner err in finding that it would have been obvious to an artisan to combine the teachings and suggestions of Wical, Suzuki, and Wittenburg?

Issue 4

The Examiner finds that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include the internet access as taught by Wittenburg in the invention of the modified Wical because it provides users with remote access to information over the WWW [world wide web]” (Ans. 9).

Appellants submit that “Wical teaches a bookshelf system for browsing information, while Wittenburg teaches a multimedia presentation such as online shopping” (App. Br. 25-26).

Issue: Did the Examiner err in finding that Wical and Suzuki would have taught or suggested an electronic catalog database that comprises a plurality of products?

Issue 5

The Examiner finds that “Wittenburg teaches generating a purchase order in response to receiving [an] action” (Ans. 9).

Appellants submit that “none of the cited references teach the generation of a purchase order” (App. Br. 26).

Issue: Did the Examiner err in finding that Wical, Suzuki, and Wittenburg would have taught or suggested generating a purchase order in response to receiving an action?

Issue 6

The Examiner finds that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include the alphabetic tab as taught by Suzuki and Bodnar in the invention of Wical in order to provide a visual presentation of all the hierarchical menu options at all levels of the hierarchical structure and to provide a visual presentation of the hierarchical relationship of all menu options at one level to another level” (Ans. 11).

Appellants submit that “Bodnar teaches a dynamic tab splitting method which teaches away from the multi-tiered tab display of the current invention” (App. Br. 27).

Issue: Did the Examiner err in finding that it would have been obvious to an artisan to combine the teachings and suggestions of Wical, Suzuki, and Bodnar?

Issue 7

The Examiner finds that Appellants’ arguments against the references individually fall short because the rejections are based on combinations of references (Ans. 14, 17).

Appellants argue that other limitations are not taught by some of the prior art references used in the rejections (App. Br. 18-27).

Issue: Did the Examiner err in finding that the prior art references would have taught or suggested other limitations of the claimed invention?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. Wical discloses a “virtual bookshelf system [that] displays a portion of the hierarchical structure including a representation of the categories. . . . In one embodiment, categories are displayed in a history section to define a current path for the hierarchical structure from the highest hierarchical level to a currently selected hierarchical level” (col. 2, ll. 24-35).
2. Wical teaches a virtual bookshelf that uses a “knowledge catalog [that] includes a set of static ontologies to define knowledge. . . . The static ontologies are configured as hierarchical structures For example, a ‘business and industry’ static ontology contains three levels of concept classifications under the highest level concept” (col. 7, ll. 24-46).
3. Wical teaches that a “user may browse the virtual bookshelf to locate information through navigation of the hierarchies” (col. 11, ll. 61-62; figs. 2a-f). “In general, when one of the high level knowledge catalog categories are selected for expansion, a list [o]f categories in the next lower level of the hierarchy for the selected item are displayed” (col. 12, ll. 1-4).
4. Wical discloses that a “virtual bookshelf also provides full text display for a selected document” (col. 17, ll. 35-36).

5. Wical teaches that “the virtual bookshelf system is analogous to a bookstore. . . . [A] person may visit a bookstore to find reference books on a selected topic” (col. 5, ll. 28-30).
6. Suzuki discloses
style-of-rendition icon windows . . . the outermost window includes tabs representing various types of musical instruments . . . any one of these musical instrument types can be selected The middle or second window includes tabs representing various articulation states . . . any one of these articulation states can be selected

Further, the third or innermost window includes tabs representing various styles of rendition . . . any one of the styles of rendition can be selected

In each of the above-mentioned style-of-rendition windows, there are also visually shown a plurality of style-of-rendition-candidate icons Thus, the user is allowed to impart articulation . . . to the musical score by just selecting a suitable one of the style-of-rendition-candidate icons.

(Col. 9, ll. 9-40; figs. 6, 12).

7. Wittenburg depicts online shopping (fig. 10).
8. Bodnar teaches a tabbed interface with tabs having labels #AB, CDE, FGH, IJK, and LMN (fig. 8A).
9. Bodnar illustrates an example where a “[a]s a result of having selected tab 801, the list 701 (now 701c) is updated and, for this example, includes a large number of ‘M’ entries” (§ [0082]; fig. 8A). The user drills down into the entries by clicking the select key, after which “the category tab has, in effect, ‘split’ into

subcategory tabs. For instance, ‘M’ entries are now represented by three tabs 811: ‘M,’ ‘Mc,’ and ‘Mo’ tabs” (§ [0083]; fig 8B).

10. Appellants do not challenge the Examiner’s finding that “Wittenburg teaches accessing the database over a network a network includes accessing the database over the Internet (fig. 1)” (Fin. Rej. 8).

PRINCIPLES OF LAW

New Arguments

“Considering an argument advanced for the first time in a reply brief . . . is not only unfair to an appellee but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered.” *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986) (internal citations omitted). “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision).

Claim interpretation

“In the patentability context, claims are to be given their broadest reasonable interpretations. . . . [L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). A claim meaning is reasonable if one of ordinary skill in the art would understand the claim, read in light of the specification, to encompass the meaning. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results,” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007), especially if the combination would not be “uniquely challenging or difficult for one of ordinary skill in the art,” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

ANALYSIS

Issue 1

Appellants challenge the Examiner’s conclusion that it would have been obvious to combine the teachings and suggestions of Wical and Suzuki. Based on Appellants’ arguments in the Appeal Brief, we will decide the

appeal of claims 1-3, 5-23, 27-31, and 37-45 with respect to issue 1 on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Wical discloses a virtual bookshelf that displays a hierarchical structure that includes a representation of categories (FF 1). Suzuki teaches the style-of-rendition icons that are displayed based on the use of tiers of tabs representing a hierarchy consisting of musical instruments, articulation states, and styles of rendition (FF 6). Both references disclose graphical user interfaces that display hierarchies of information. It would have been obvious to an artisan possessing creativity and common sense to combine the teachings and suggestions of Wical and Suzuki to yield predictable results (a virtual bookshelf that displays a hierarchical structure using tabs).

To show that it would not have been obvious to modify Wical, Appellants present “several differences between Wical and the current invention” (App. Br. 21). First, Appellants argue that “the ‘expand’ button is pressed to generate a lower level of categories” (*id.*). We find this unpersuasive. Wical teaches selecting a category for expansion (FF 3). This teaching falls within a reasonable interpretation of the claimed selecting. Then, Appellants argue that “the ‘first page’ of the hierarchical structure is displayed rather than a tier of tabs, and a scroll bar is provided for scrolling up or down the hierarchy” (App. Br. 21). This is an unpersuasive attack on Wical individually, even though the rejection is based on Wical and Suzuki. Appellants also fail to identify claim language that precludes scroll bars. Finally, Appellants argue is that “[i]n Wical, once a category is selected, it is moved to a separate history section rather than remaining in the same place

in the navigation section” (*id.*). We find this unpersuasive because Appellants fail to identify claim language requiring a category selection interface to remain fixed once selected. Appellants also fail to show why such an interface would not be obvious in light of the combined teachings and suggestions of Wical and Suzuki.

Appellants further argue that “Wical is not suited to a tiered display because of the variable levels of the hierarchical structure” (App. Br. 21). This argument is unpersuasive because Appellants fail to identify claim language requiring a fixed number of tiers. Appellants also fail to provide arguments or evidence to demonstrate that it would not have been obvious to an artisan to adapt the variable-level hierarchical technology of Wical to use a fixed-level hierarchy instead. Furthermore, Wical teaches a business and industry ontology with three levels of concept classification, thus at least suggesting a three-level fixed hierarchy (FF 2).

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner’s 35 U.S.C. § 103(a) rejection of claim 1, and of claims 2, 3, 5-23, 27-31, and 37-45 which fall therewith.

Issue 2

Appellants challenge the Examiner’s finding that Wical and Suzuki would have taught or suggested responding to a third tier tab selection by displaying a page from an electronic catalog database. Based on Appellants’ arguments in the Appeal Brief, we will decide the appeal of claims 1-3, 5-23, 27-31, and 37-45 with respect to issue 2 on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Suzuki teaches displaying a plurality of style-of-rendition icons in response to selection of a third-tier styles-of-rendition tab (FF 6). Wical teaches presentation of a list of categories in the next lower level of a knowledge catalog hierarchy (FF 3). Thus, Wical and Suzuki would have taught or suggested in response to a selecting of a tab of a third tier (from the styles of rendition tabs), displaying a page (the next lower level) from an electronic catalog database (of a knowledge catalog hierarchy).

Appellants argue that “this page is not the content of an electronic database—it is a portion of the hierarchical structure generated by Wical” (App. Br. 21). This is unpersuasive. Appellants fail to show why a knowledge catalog is not an electronic database. Appellants also fail to show why a display of a lower level of hierarchy is not a page. Furthermore, Wical teaches full text display for a selected document (FF 4), thus at least suggesting display of a page from an electronic catalog database.

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner’s 35 U.S.C. § 103(a) rejection of claim 1, and 2, 3, 5-23, 27-31, and 37-45 which fall therewith.

Issue 3

Appellants argue that the Examiner erred in finding that Wical teaches an electronic catalog database that comprises a plurality of products. Yet, Wical teaches that its virtual bookshelf system is analogous to a bookstore, enabling a person to find reference books on a selected topic (FF 5). Appellants fail to show why a reference book is not a product.

For at least these reasons, we find no evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejection of claim 7.

Issue 4

We are not convinced by Appellants' unsubstantiated allegation that "[t]he references of Wical, Suzuki, and Wittenburg are not reasonably combined to form an obviousness rejection of claim 17" (App. Br. 25).

Appellants' submission that Wical teaches a bookshelf system while Wittenburg teaches multimedia presentation does not demonstrate error in the Examiner's finding that Wittenburg teaches accessing a database over the Internet (FF 10). The submission also fails to demonstrate error in the Examiner's rationale that an artisan would have combined the references to "provide[] users with remote access to information over the WWW [world wide web]" (Ans. 9). Furthermore, Wical teaches that a virtual bookshelf system is analogous to a bookstore (FF 5). This teaching suggests shopping, thus providing a nexus with the online shopping teachings of Wittenburg.

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner's 35 U.S.C. § 103(a) rejection of claim 17.

Issue 5

We are unconvinced by Appellants' allegation that "none of the cited references teach the generation of a purchase order as claimed in claim 41" (App. Br. 26). Appellants admit that Wittenburg teaches Internet commerce and online shopping (*id.*; FF 7). However, Appellants fail to distinguish

generating a purchase order in response to receiving an action from Internet commerce or online shopping.

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner's 35 U.S.C. § 103(a) rejection of claim 41.

Issue 6

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal of claims 27-31 with respect to issue 6 on the basis of claim 27 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As discussed above, it would have been obvious to combine the teachings and suggestions of Wical and Suzuki. Appellants submit that "Bodnar teaches a dynamic tab splitting method which teaches away from the multi-tiered tab display of the current invention" (App. Br. 27). Suzuki teaches the use of a multi-tiered tabbed interface (FF 6). Bodnar teaches alphabetic tabs (FF 8) and a method for assigning category tab labels based on category-splitting (FF 9). Appellants fail to show why Bodnar's category-splitting technique would have discouraged an artisan from using alphabetic tabs with other tabbed interfaces, such as a multi-tiered tabbed interface. Thus, we find that the use of alphabetic tabs in a multi-tiered tabbed interface would have been a predictable combination of familiar elements.

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner's 35 U.S.C. § 103(a) rejection of claim 27, and 28-31 which fall therewith.

Issue 7

Appellants challenge additional findings of the Examiner, but the Examiner finds that these challenges fail to address rejections based on a combination of references. We agree with the Examiner.

Appellants make multiple attacks on Wical individually, arguing that Wical does not teach certain claim limitations. For example, Appellants argue that “Wical does not teach ‘presenting a first tier of tabs, each tab in the first tier of tabs representing . . .’” (App. Br. 18) (emphasis added). Yet, the Examiner relies on Wical as teaching “presenting a first tier of menu options, each menu option in the first tier of menu options representing . . .” (Fin. Rej. 2) (emphasis added). The Examiner relies on Suzuki to teach “hierarchical menu options [that] are displayed as graphical tabs” (Fin. Rej. 3).

Appellants present other arguments that fail to take into account all of the references used in the rejections. For example, Appellants argue that claim 3 “is not anticipated by Wical” (App. Br. 22), despite the Examiner’s use of both Wical and Suzuki in the rejection of parent claim 1 (Fin. Rej. 2-4). Similarly, Appellants argue that “[n]either Wical nor Bodnar teach ‘displaying the first page represented by the page number tab’ as claimed in claim 27” (App. Br. 27), even though the Examiner also relies on Suzuki in the rejection (Fin. Rej. 9-11).

Appellants admit, at least with respect to claim 1, that “the language of the Supplemental Appeal Brief may be subject to this interpretation [that the arguments attack the references separately]” (Reply Br. 1). Appellants

submit that it was not their “intention to argue simply that Wical’s failure to teach tabs overcomes the rejection” (Reply Br. 2). However, Appellants must present their arguments through the Appeal Brief’s objective meaning. We do not expect an Examiner to answer to Appellants’ subjective, undisclosed, intended arguments. Appellants’ efforts to advance such arguments in the Reply Brief are untimely, and thus waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004). We decline to address any new arguments not originally presented in the principal Brief with respect to all claims before us on appeal. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative).

For at least these reasons, we find no evidence persuasive of error with respect to this issue in the Examiner’s 35 U.S.C. § 103(a) rejections of claims 1-3, 5-23, 27-31, and 37-45.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we find no evidence persuasive of error in the Examiner’s findings:

1. that it would have been obvious to an artisan to combine the teachings and suggestions of Wical and Suzuki (issue 1);
2. that Wical and Suzuki would have taught or suggested in response to a selecting of a tab of a third tier, displaying a page from an electronic catalog database (issue 2);
3. that it would have been obvious to an artisan to combine the teachings and suggestions of Wical, Suzuki, and Wittenburg (issue 3);

4. that Wical and Suzuki would have taught or suggested an electronic catalog database that comprises a plurality of products (issue 4);

5. that Wical, Suzuki, and Wittenburg would have taught or suggested generating a purchase order in response to receiving an action (issue 5);

6. that it would have been obvious to an artisan to combine the teachings and suggestions of Wical, Suzuki, and Bodnar (issue 6); and

7. that the prior art references would have taught or suggested other limitations of the claimed invention (issue 7).

DECISION

We affirm the Examiner's decisions rejecting claims 1-3, 5-23, 27-31, and 37-45 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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